IN THE

Supreme Court of the United States

October Term, 1941

No. 321

STONITE PRODUCTS COMPANY,
Petitioner,

vs.

THE MELVIN LLOYD COMPANY, and
J. A. ZURN MFG. CO.,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Respondent, J. A. Zurn Mfg. Co., by Isaac J. Silin, Esquire, respectfully prays that a writ of certiorari to review a decision of the Circuit Court of Appeals for the Third Circuit entered May 13, 1941, be denied.

A transcript of the record in the case, including the proceedings, has been furnished by the Petitioner, who has also referred to the opinions below.

QUESTION PRESENTED

Is the conclusion of the Circuit Court of Appeals for the Third Circuit (R. p. 21)

> "that the provisions of Section 52 authorizing a single suit to be brought against defendants residing in different districts in a state divided into judicial districts apply to patent suits to the same extent as to other non local suits and that the district court erred in holding otherwise."

correct?

STATUTES INVOLVED

The Statutes involved will be found in the Appendix to the Petitioner's Brief.

REASONS FOR DENYING THE WRIT

I. The Decision Below Is Not in Conflict with Any Applicable Decisions of This Court

One of the points relied on by the Petitioner for invoking the discretionary jurisdiction of this Court is that the decision below is in conflict with decisions of this Court. In support thereof Petitioner contends that this Court has indicated that general statutes regarding venue do not apply to patent cases. Among the authorities cited are *In re Hohorst*, 150 U. S. 633, 661, and *In re Keasbey & Mattison Co.*, 160 U. S. 221, 230.

In *In re Hohorst, supra,* the question before the Court was whether the Act of March 3, 1887, as amended, providing in part that "no civil suit shall be brought before either of said Courts against any person by any original process or proceeding in any other district than that whereof he is an inhabitant" prevented the Federal Courts from having jurisdiction in patent litigation over a German Corporation which was not an "inhabitant" of any State. This Court first held that the statute was applicable only to an inhabitant of the United States, and secondly, that from its context it referred only to cases arising under the jurisdiction of the Federal Courts concurrent with that of the State Courts, and so was inapplicable to patent litigation, part of the exclusive jurisdiction of the Federal Courts. Therefore, it appears that the Court did not hold that general statutes as to venue are not applicable to patent cases but that this particular statute was inapplicable to patent cases

because it was not a general statute and only referred to a certain class of litigation where concurrent jurisdiction existed.

This interpretation is strengthened by the second cited case, *In re Keasbey & Mattison Co.*, 160 U. S. 221, in which the Court distinguished In re Hohorst, and said of that case at page 230:

> "It was a suit for infringement of a patent right, exclusive jurisdiction of which had been granted to the Circuit Courts of the United States by section 629, cl. 9 and section 711, cl. 5 of the Revised Statutes, re-enacting earlier Acts of Congress; and was, therefore, not affected by general provisions *regulating* the *jurisdiction* of the Courts of the United States, *concurrent with that of the several States.*" (Italics supplied)

This Court then held that inasmuch as trade-mark litigation was within the concurrent jurisdiction of the Federal Courts, the Act of March 3, 1887 (supra) was applicable.

As Section 52 of the Judicial Code, 28 U. S. C. 113, (appendix, Petitioner's Brief) is not limited to cases of concurrent jurisdiction or otherwise limited in its application, the decision below does not conflict with the decisions of this Court.

The other decision of this Court cited by the Petitioner is *General Electric Co. v. Marvel Rare Metals Co.*, 287 U. S. 430. In that case this Court was considering Section 48 of the Judicial Code, 28 U. S. C. 109 (appendix, Petitioner's Brief) as to the venue of patent cases and whether those provisions could be and were waived by starting action in another district than the districts specified in the statute. The Court said of Section 48 at page 435 of the opinion:

> "It confers upon defendants in patent cases a privilege in respect of the places in which suits may be maintained against them; and that privilege may be waived."

It cannot be held that thereby this court decided that all other venue statutes were inapplicable to patent cases. In fact, it may be reasoned that from the Marvel case it is to be inferred that if Section 48 may be waived by a private party, a fortiori, its operation certainly may be limited by the operation of a statute such as Section 52 of the Judicial Code.

It is, therefore, submitted that the decision below is not in conflict, or probably in conflict, with any applicable decisions of this Court.

II. Prior Decision in the Third Circuit

The attention of the Court is directed to the case of *Zell vs. Erie Bronze Co.*, 273 Fed. 833 (1921), in the Eastern District of Pennsylvania in which the Court also held that Section 52 of the Judicial Code was applicable to suits for patent infringement.

In the Third Circuit there has been no contrary decision which has come to the knowledge of counsel for the Respondents in any book reporting decisions of the Third Circuit.

III. Exercise of Discretion for Denial of Certiorari in Clear Cases

Judge Maris and the Circuit Court of Appeals for the Third Circuit concluded (R. p. 21)

"that the provisions of Section 52 authorizing a single suit to be brought against defendants residing in different districts in a state divided into judicial districts apply to patent suits to the same extent as to other non local suits and that the district court erred in holding otherwise."

The clarity of this conclusion, the convincing grounds on which it is based and the fact that it squares with the conceptual apparatus used in arriving at other conclusions in this field of the law, support a request that certiorari be denied in the discretion of the Court.

The Supreme Court of the United States, it is submitted, can well hold that the reargument before it of the question involved in this case is not required in view of these factors.

CONCLUSION

Your Respondent respectfully prays your Honorable Court that the Writ of Certiorari prayed for in the above entitled case be denied.

Respectfully submitted,
ISAAC J. SILIN, ESQUIRE,
Counsel for Respondent.